

**B) Remarks:****Request for Withdrawal of Finality:**

Applicant respectfully requests that the finality of the Office action of December 5, 2003 be withdrawn and the case be reopened because claim 29 has been improperly rejected under 102(e). Specifically, the Examiner rejected claim 29 under 102(e); yet, the Examiner provided an obvious statement to meet the limitation of claim 29 under the 102(e) rejection. Therefore, an improper Office action has been issued to Applicant, and Applicant, therefore, is not aware of the status of claim 29 relative to the applied art.

**Response to Claim Objections:**

The Examiner has indicated that claim 27 is identical to claim 26. However, claim 26, which is drawn to repositioning a screen cursor without physical movement of the mouse system, is not identical to claim 27, which is drawn to repositioning of a screen cursor without physical movement of the mechanical mouse button.

**Response to Claim Rejections:**

1. Claims 1, 2, 5-7, 10, 12, 22, 24-29, 33, and 34 have been rejected under 35 U.S.C. 102(e) as being unpatentable by U.S. Patent No. 6,359,611 to Chan.

- **Specifically regarding the rejection of claim 1:**

The Examiner indicates that Chan teaches a mouse system with at least one mechanical mouse button. The Examiner indicates in Chan that there is a touch pad 155 that is integrated into the cavity of button 125.

However, Chan does not teach a touch pad integrated into the cavity of a mechanical mouse button. Nor does Chan teach using a touch pad at all. Chan actually teaches away from using touch pads by describing what are believed by Chan to be disadvantages of touch pads. At column 2, lines 11-12, Chan teaches that *"The touch pad also suffers from similar disadvantages when making a selection."* And at column 2, lines 19-22, Chan teaches with respect to touch pads that *"Because there is no distinct mechanical clicking associated with the act of selection, the user is not provided with an immediate sensory feedback to signal a successful selection."* Accordingly, it is neither the intention nor the desire of Chan to

incorporate touch pads into a computer mouse. In the rejection, the Examiner indicated that item 155 is a touch pad. However, Chan discloses that item 155 is a depression (see column 5, line 15). Also, at column 5, lines 24-26, Chan discloses “...*extending index finger F against the wall of depression 155, causing mouse 100 to move in the y direction.*” And at column 5, lines 27-29, “...*movement of index finger F against the wall of depression 155, causing the mouse 100 to move in the x direction.*” Accordingly, item 155 is a depression and not a touch pad, and Chan does not teach a touch pad in the cavity of a mechanical mouse button. The depression functions to aid the user of the mouse to move the mouse in a particular direction and does not and could not function as a touch pad.

Applicant’s invention specifically teaches that the touch pad is built and contained *in a cavity opening* of the mechanical touch pad button. The Chan reference does not teach this limitation.

Chan also describes the use of a roller ball with the mouse for determining movement of the mouse. It is noted that the mouse of Applicant’s invention is not moved over a surface and does not use a mouse ball (see column 5, line 66 through column 6, line 5). The Chan reference is replete with descriptions of how the mouse is moved so as to reposition the cursor.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claim 1. Accordingly, the Examiner has not shown that Applicant’s claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

• **Specifically regarding the rejection of claim 2:**

The rejection of claim 2 should be withdrawn because the Chan reference does not teach the combination of claims 1 and 2, wherein the claimed structure of a mechanical mouse button is not taught as having a touch pad integrated into a cavity opening formed in the mouse press button.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claim 2. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 5:**

Applicant's claim 5 requires that the mechanical mouse button have at least one finger-pressing device formed thereon. The Examiner refers to item 155 as "*a finger controlled depression (column 5, 26-29).*" However, this statement is unclear in that the Examiner has previously indicated item 155 as the touch pad (see Examiner's rejection). It is noted that the Chan reference fails to teach a finger pressing device as claimed.

The rejection of claim 5 should additionally be withdrawn for the reasons stated above with respect to claim 1, as claim 5 depends directly from claim 1.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claim 5. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 6:**

The limitations of claim 6 specify that the auxiliary computer mouse functions to point and to reposition a screen cursor without physical movement of said auxiliary computer mouse. That is, an auxiliary mouse of the instant invention is not moved across a surface in order to position a screen cursor, as is the auxiliary mouse system taught by Chan and relied upon by the Examiner. Applicant's invention does not require movement of the mouse across a surface in order to point with a screen arrow or to

reposition a screen cursor. It is noted that Chan teaches at column 2, lines 33-35 that *“There is also a need for a smaller electronic mouse that can operate on a mouse pad with a smaller footprint.”* Chan also teaches *“Another object of the present invention is to provide an electronic mouse that can operate over a mouse pad with a small footprint.”* (see column 2, lines 55-57). Chan describes at column 2, line 66 through column 3, line 1 that *“The translation of the mouse can be controlled by the index finger placed over the primary selection button.”* And at column 3, lines 3-6 *“Means for facilitating translation of the position of the mouse include...concave depressions, protrusions...”* Chan discloses at column 3, lines 54-61 *“...this embodiment of mouse may include a rubberized ball...located on the bottom 115 of the mouse, directly below primary button 125. An alternative embodiment may employ an electrical pickup...which detects movement of the mouse relative to an accompanying pad.”* It is disclosed at column 4, lines 4-7 that *“...a small mouse pad 150...to provide traction for a rubberized ball.”* Chan also describes cursor positioning by *“Flexing thumb T and middle finger M pulls mouse 100 in the negative y direction...causing corresponding cursor movement.”* (see column 4, lines 28-31). Chan also discloses at column 4, lines 47-50 that *“Where large movement of the cursor is desired, such as moving the cursor from one edge of the display screen to the opposite edge, mouse 100 is moved with a sweeping motion...”* Accordingly, it is seen that the teachings of Chan require movement of the mouse in order to reposition a screen cursor.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claim 6. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 7:**

The rejection of claim 7 should be withdrawn because the Chan reference does not teach the combination of claims 6 and 7, wherein the claimed structure of a mechanical mouse button is not taught in conjunction with an auxiliary computer mouse that functions to point and reposition a screen cursor without physical movement of the auxiliary computer mouse.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claims 6 and 7. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 10:**

Claim 10 requires that a touch pad is integrated into a cavity opening formed in the mechanical mouse button.

The Examiner indicates that there is a touch pad 155 that is integrated into the cavity of button 125. As clearly shown in Figure 1 of the Chan reference, this is clearly not the case. Item 155 is merely a depression of button 125.

Also, Chan does not teach a touch pad integrated into the cavity of a mechanical mouse button. Nor does Chan teach using a touch pad at all. Chan actually teaches away from using touch pads. At column 2, lines 11-12, Chan teaches that *"The touch pad also suffers from similar disadvantages when making a selection."* And at column 2, lines 19-22, Chan teaches with respect to touch pads that *"Because there is no distinct mechanical clicking associated with the act of selection, the user is not provided with an immediate sensory feedback to signal a successful selection."* Accordingly, it is neither the intention nor the desire of Chan to incorporate touch pads into a computer mouse. In the rejection, the Examiner indicated that item 155 is a touch pad. However, Chan discloses that item 155 is a depression (see column 5, line 15). Also, at column 5, lines 24-26, Chan discloses

*“...extending index finger F against the wall of depression 155, causing mouse 100 to move in the y direction.”* And at column 5, lines 27-29, *“...movement of index finger F against the wall of depression 155, causing the mouse 100 to move in the x direction.”* Accordingly, item 155 is a depression and not a touch pad, and Chan does not teach a touch pad in the cavity of a mechanical mouse button. The depression functions to aid the user of the mouse to move the mouse in a particular direction and does not and could not function as a touch pad.

Applicant's invention specifically teaches that the touch pad is built and contained *in a cavity opening* of the mechanical touch pad button. The Chan reference does not teach these limitations.

It is noted that the mouse of Applicant's invention is not moved over a surface and does not use a mouse ball, as does Chan.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claim 10. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 12:**

The rejection of claim 12 should be withdrawn because the Chan reference does not teach the combination of claims 6 and 12, wherein the claimed structure of a mechanical mouse button is not taught in conjunction with an auxiliary computer mouse that functions to point and reposition a screen cursor without physical movement of the auxiliary computer mouse.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claims 6 and 12. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 22:**

The rejection of claim 22 should be withdrawn because the Chan reference does not teach the combination of claims 1 and 22, wherein the claimed structure of a mechanical mouse button is not taught as having a touch pad integrated into a cavity opening formed in the mouse button.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claims 1 and 22. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 24:**

The limitations of claim 24 specify that the portable computer mouse system does not require physical repositioning of said mouse system to position or manipulate a screen cursor. That is, an auxiliary mouse of the instant invention is not moved across a surface in order to position a screen cursor, as is the auxiliary mouse system taught by Chan and relied upon by the Examiner. Accordingly, Applicant's invention does not require movement of the mouse across a surface in order to position or manipulate a screen cursor. It is noted that Chan teaches at column 2, lines 33-35 that *"There is also a need for a smaller electronic mouse that can operate on a mouse pad with a smaller footprint."* Chan also teaches *"Another object of the present invention is to provide an electronic mouse that can operate over a mouse pad with a small footprint."* (see column 2, lines 55-57). Chan describes at column 2, line 66 through column 3, line 1 that *"The translation of the mouse can be controlled by the index finger placed over the primary selection button."* And that at column 3, lines 3-6 *"Means for facilitating translation of the position of the mouse include...concave depressions, protrusions..."* Chan discloses at column 3, lines 54-61 *"...this embodiment of mouse may include a rubberized ball...located on the bottom 115 of the mouse, directly*

*below primary button 125. An alternative embodiment may employ an electrical pickup...which detects movement of the mouse relative to an accompanying pad.*” It is disclosed at column 4, lines 4-7 that “...a small mouse pad 150...to provide traction for a rubberized ball.” Chan also describes cursor positioning by “*Flexing thumb T and middle finger M pulls mouse 100 in the negative y direction...causing corresponding cursor movement.*” (see column 4, lines 28-31). Chan also discloses at column 4, lines 47-50 that “*Where large movement of the cursor is desired, such as moving the cursor from one edge of the display screen to the opposite edge, mouse 100 is moved with a sweeping motion...*” Also, at column 4, lines 55-59, Chan teaches that “*Next, the user lifts the mouse 100 up off mouse pad 150...*” Accordingly, it is seen that the teachings of Chan require movement of the mouse in order to reposition or manipulate a screen cursor.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claim 24. Accordingly, the Examiner has not shown that Applicant’s claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 25:**

The limitations of claim 25 require that “at least one wall forming said cavity opening in said mechanical mouse button remains in a face-to-face relationship with at least one wall of the touch pad during manipulation of said at least one mechanical mouse button.” The Examiner rejected the claim indicating that “*the housing cavity and touch pad coincide in position during physical manipulation...the touch pad extends into the cavity.*”

However, as indicated previously Chan does not teach a touch pad integrated into the cavity of a mechanical mouse button. Nor does Chan teach using a touch pad at all. Chan actually teaches away from using touch pads by describing what are believed by Chan to be disadvantages of touch pads. At column 2, lines 11-12, Chan teaches that “*The touch pad also suffers from*



*similar disadvantages when making a selection.*” And at column 2, lines 19-22, Chan teaches with respect to touch pads that *“Because there is no distinct mechanical clicking associated with the act of selection, the user is not provided with an immediate sensory feedback to signal a successful selection.”* Accordingly, it is neither the intention nor the desire of Chan to incorporate touch pads into a computer mouse. In the rejection, the Examiner indicated that item 155 is a touch pad. However, Chan discloses *“Depression 155...may include a small protrusion 160...that engages the inserted finger tip P.”* (see column 5, lines 15-17; Drawings). Accordingly, there is no touch pad integrated into a cavity opening formed in the mechanical mouse button such that at least one wall forming the cavity opening remains in a face-to-face relationship with a wall of the touch pad during manipulation of the mechanical mouse button, as required by claims 1 and 25. Also, at column 5, lines 24-26, Chan discloses *“...extending index finger F against the wall of depression 155, causing mouse 100 to move in the y direction.”* And at column 5, lines 27-29, *“...movement of index finger F against the wall of depression 155, causing the mouse 100 to move in the x direction.”* Accordingly, item 155 is a depression and not a touch pad, and Chan does not teach a touch pad in the cavity opening of a mechanical mouse button, nor is the claimed structure met by Chan. The depression 155 functions to aid the user of the mouse to move the mouse in a particular direction and does not and could not function as a touch pad.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claim 25. Accordingly, the Examiner has not shown that Applicant’s claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

• *Specifically regarding the rejection of claim 26:*

The limitations of claim 26 specify that the portable computer mouse system does not require physical movement of said mouse system to point and

reposition a screen cursor. That is, an auxiliary mouse of the instant invention is not moved across a surface in order to position a screen cursor, as is the auxiliary mouse system taught by Chan and relied upon by the Examiner. Accordingly, Applicant's invention does not require movement of the mouse across a surface in order to point with a screen arrow or to reposition a screen cursor. It is noted that Chan teaches at column 2, lines 33-35 that *"There is also a need for a smaller electronic mouse that can operate on a mouse pad with a smaller footprint."* Chan also teaches *"Another object of the present invention is to provide an electronic mouse that can operate over a mouse pad with a small footprint."* (see column 2, lines 55-57). Chan describes at column 2, line 66 through column 3, line 1 that *"The translation of the mouse can be controlled by the index finger placed over the primary selection button."* And that at column 3, lines 3-6 *"Means for facilitating translation of the position of the mouse include...concave depressions, protrusions..."* Chan discloses at column 3, lines 54-61 *"...this embodiment of mouse may include a rubberized ball...located on the bottom 115 of the mouse, directly below primary button 125. An alternative embodiment may employ an electrical pickup...which detects movement of the mouse relative to an accompanying pad."* It is disclosed at column 4, lines 4-7 that *"...a small mouse pad 150...to provide traction for a rubberized ball."* Chan also describes cursor positioning by *"Flexing thumb T and middle finger M pulls mouse 100 in the negative y direction...causing corresponding cursor movement."* (see column 4, lines 28-31). Chan also discloses at column 4, lines 47-50 that *"Where large movement of the cursor is desired, such as moving the cursor from one edge of the display screen to the opposite edge, mouse 100 is moved with a sweeping motion..."* Also, at column 4, lines 55-59, Chan teaches that *"Next, the user lifts the mouse 100 up off mouse pad 150..."* Accordingly, it is seen that the teachings of Chan require physical movement of the mouse in order to reposition a screen cursor.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claim 26.

Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 27:**

The limitations of claim 27 specify that the mouse system functions to point and reposition a screen cursor without physical movement of the mechanical mouse button. However, the Chan reference describes at column 5, lines 47-49 that *"Once the cursor is proximate to a desired object on the display screen, the user selects the object by clicking primary button 125."* Chan also discloses at column 5, lines 51-54 that *"To drag the object, the user maintains force on primary button 125 with index finger F while, at the same time, moving mouse 100 with the same index finger F."* Accordingly, the Chan reference requires movement of the mechanical mouse button for pointing and repositioning of a screen selector.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claim 27. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 28:**

The limitations of claim 28 specify that the mechanical mouse button and touch pad are adapted to move together in a desired direction relative to the mouse system housing. Because the Chan reference does not include a touch pad, the limitation is not met. Chan does not teach use of a touch pad, nor does Chan teach a touch pad integrated into a cavity opening of a mechanical mouse button, wherein the mechanical mouse button and touch pad are adapted to move together in a desired direction relative to the mouse system housing.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claim 28. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 29:**

Applicant is unclear as to the Examiner's basis of rejection for claim 29. The Examiner has indicated that claim 29 is rejected under 102(e), but has provided an obvious statement in the body of the rejection of claim 29 by stating "*It would have been obvious to add a light because of the extreme conventionality of the practice that increases aesthetic value and also acts as location cue in the dark.*" The Chan reference does not teach the use of backlighting. Accordingly, the basis of the rejection is improper. Further, the Examiner has not provided a reference that teaches backlighting a mechanical mouse button with a touch pad integrated in the cavity opening of the mechanical mouse button. The Examiner is requested to provide a reference supporting the statement that it is well known to backlight a mechanical mouse button having an integrated touch pad in the cavity opening of a mechanical mouse button for the reasons provided.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claim 29. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 33:**

The limitations of claim 33 specify that at least one wall forming the cavity opening in the mechanical mouse button is in a face-to-face

relationship with at least one wall of the touch pad. Because the Chan reference does not include a touch pad, the limitation is not met. Chan does not teach use of a touch pad, nor does Chan teach a touch pad integrated into a cavity opening of a mechanical mouse button, wherein at least one wall forming the cavity opening in the mechanical mouse button is in a face-to-face relationship with at least one wall of the touch pad.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claim 33. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 34:**

The limitations of claim 34 specify that at least one wall of the touch pad extends into the cavity opening. Because the Chan reference does not include a touch pad, the limitation is not met. Chan does not teach use of a touch pad, nor does Chan teach a touch pad integrated into a cavity opening of a mechanical mouse button, wherein at least one wall of the touch pad extends into the cavity opening.

A claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference. For these reasons, Applicant submits that Chan does not anticipate the claimed subject matter of claim 34. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of Chan and is requested to withdraw this rejection.

**2. Claims 3, 4, 8, and 9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Chan U.S. Patent No. 6,359,611 in view of Howard et al.**

**• Specifically regarding the rejection of claims 3, 4, 8, and 9:**

It is noted that the Howard et al. Patent Number is not indicated in the rejection. Applicant assumes the Examiner is referring to U.S. Patent Number: 5,268,674 since this reference was used in the previous Office Action.

The Examiner has indicated that Chan teaches a press button and that Howard et al. teach that the different button types claimed are well known in the art. However, the press button limitations of Applicant's claims are not met by the Howard et al. reference. Specifically, Howard et al. do not teach a press button as defined by Applicant's invention. Therefore, Howard et al. do not teach the equivalency of press buttons to press and lock buttons and sliding panel buttons. Accordingly, there is no suggestion or motivation in the Howard et al. reference to lead one to replace the press button of Chan with a press and lock button or a sliding panel button. Howard et al. simply does not teach the equivalency of the claimed mouse button types. Merely finding the different button designs in different references is not motivation to combine the references. The references must provide the motivation. Chan is specific in the type of button design to be used, because it functions properly in the Chan invention. There is no suggestion in the Chan reference that the disclosed mouse button design is open to modification or replacement. Such a suggestion broadens the scope of the Chan patent to include subject matter not taught by Chan patent. It must be shown that the prior art could be modified and there exists a suggestion of the desirability or motivation for making the modification. Chan does not provide this motivation or desire. Nor, does the scope of the Chan patent lend itself to modification. Chan is specific in the type of mouse button design and type that will function in the Chan computer mouse. Therefore, it would not have been obvious to have modified the Chan reference as suggested by the Examiner. Therefore, the Examiner cannot rely on Howard et al. for motivation to modify Chan. Further, the Howard et al. reference does not overcome the deficiencies of the Chan reference with

regard to claim 1. Accordingly, the rejection of claims 3 and 4 should be withdrawn for the reasons stated above with respect to claim 1, as claims 3 and 4 depend directly from claim 1. Additionally, the rejection of claims 8 and 9 should be withdrawn for the reasons stated above with respect to claim 6, as claims 8 and 9 depend directly from claim 6.

The Examiner further indicates, “In reference to claims 3, 4, 8, and 9, there is no disclosed criticality as to why a press and lock button or a slide panel button must be used in the claimed invention.” And that “Nowhere in the specification does the applicant explicitly outline the unique advantages of implementing these particular button types.” In response, there is no requirement that an invention produce an advantage or provide criticality to be patentable – it need only be non-obvious.

Therefore, it would not have been obvious to have incorporated the mechanical buttons of Howard et al. in the invention of Chan because Howard et al. do not teach the equivalency of press buttons to press and lock buttons and sliding panel buttons and Chan is specific for a single type of button design. Further, combining the two references does not produce Applicant’s claimed invention.

For these reasons, Applicant submits that the combination of Chan and Howard et al. does not suggest or make obvious the claimed subject matter of claims 3, 4, 8, and 9. Accordingly, the Examiner has not shown that Applicant’s claimed product is structurally the same as that of the cited references and the Examiner is requested to withdraw this rejection.

- 3. Claims 11, 30, and 31 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Chan U.S. Patent No. 6,359,611 in view of Gillick et al. U.S. Patent No. 5,530,455.**

• **Specifically regarding the rejection of claim 11:**

The limitations of claim 11 specify that the touch pad is integrated into a cavity opening formed in a sidewall of the auxiliary computer mouse. The Examiner has cited Gillick et al. as teaching a side button 25 on a computer

mouse as being equivalent to a touch pad, as claimed by Applicant. However, the button 25 of Gillick et al. is not equivalent to a touch pad. Further, the Gillick et al. reference does not at all address the use of a touch pad. Additionally, Chan does not teach use of a touch pad, nor does Chan teach a touch pad integrated into a cavity opening of a mechanical mouse button or in a cavity opening formed in a sidewall of the computer mouse. Additionally, the mouse of Chan will not accommodate sidewall buttons because the conforming groove 122 of the wall 110 (sidewall) of the Chan mouse is reserved for the fitting of thumb T and middle finger M. The groove prevents the mouse from slipping off the thumb T and middle finger M when the mouse is picked up (see column 4, lines 13-17; column 3, lines 45-49; Drawings). Additionally, groove 122 accommodates arms 210 for snapping rear extension 200 to mouse 100 (see column 6, lines 15-19; Drawings). Accordingly, buttons or touch pads on the sidewall surface of the Chan computer mouse would interfere with the ability of the user to physically manipulate the mouse or add the rear extension, as Chan teaches.

Therefore, it would not have been obvious to have included a touch pad or a button in a sidewall cavity of the computer mouse of Chan because 1) neither the Chan reference nor the Gillick et al. reference teaches use of a touch pad, and 2) because buttons or touch pads on the sidewall surfaces of the Chan computer mouse would interfere with the ability of the user to physically manipulate the mouse or to allow for addition of the rear extension, as Chan teaches.

For these reasons, Applicant submits that the combination of Chan and Gillick et al. does not suggest or make obvious the claimed subject matter of claim 11. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of the cited references and the Examiner is requested to withdraw this rejection.

• **Specifically regarding the rejection of claim 30:**

The limitations of claim 30 specify that the mouse button is integrated into a cavity opening formed in a sidewall and the touch pad is integrated into an



area of the auxiliary computer mouse. The Examiner has cited Gillick et al. as teaching a side button 25 on a computer mouse as being equivalent to a touch pad and/or a computer mouse button. However, the button 25 of Gillick et al. is not equivalent to a touch pad. Further, the Gillick et al. reference does not at all address the use of a touch pad. Additionally, Chan does not teach the use of a touch pad, nor does Chan teach a touch pad integrated into a cavity opening of a mechanical mouse button or in a cavity opening formed in an area of the computer mouse. The Examiner has indicated that it would have been obvious to have included an additional button on the side of the mouse of Chan. However, the mouse of Chan will not accommodate sidewall buttons because the conforming groove 122 of the wall 110 (sidewall) of the Chan mouse is reserved for the fitting of thumb T and middle finger M. The groove prevents the mouse from slipping off the thumb T and middle finger M when the mouse is picked up (see column 4, lines 13-17; column 3, lines 45-49; Drawings). Additionally, groove 122 accommodates arms 210 for snapping rear extension 200 to mouse 100 (see column 6, lines 15-19; Drawings). Accordingly, buttons or touch pads on the sidewall surface of the Chan computer mouse would interfere with the ability of the user to physically manipulate the mouse or add the rear extension, as Chan teaches.

Therefore, it would not have been obvious to have included a touch pad or a button in a sidewall cavity of the computer mouse of Chan because 1) neither the Chan reference nor the Gillick et al. reference teaches use of a touch pad, and 2) because buttons or touch pads on the sidewall surfaces of the Chan computer mouse would interfere with the ability of the user to physically manipulate the mouse or to allow for addition of the rear extension, as Chan teaches.

For these reasons, Applicant submits that the combination of Chan and Gillick et al. does not suggest or make obvious the claimed subject matter of claim 30. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of the cited references and the Examiner is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 31:**

The limitations of claim 31 specify that the mouse touch pad is integrated into an area of the computer mouse. The Examiner has cited Gillick et al. as teaching a side button 25 on a computer mouse as being equivalent to a touch pad. However, the button 25 of Gillick et al. is not equivalent to a touch pad. Further, the Gillick et al. reference does not at all address the use of a touch pad. Additionally, Chan does not teach the use of a touch pad, nor does Chan teach a touch pad integrated into a cavity opening of a mechanical mouse button or in a cavity opening formed in an area of the computer mouse. The Examiner has indicated that it would have been obvious to have included an additional button/touch pad on the side of the mouse of Chan. However, the mouse of Chan will not accommodate sidewall buttons/touch pads because the conforming groove 122 of the wall 110 (sidewall) of the Chan mouse is reserved for the fitting of thumb T and middle finger M, as disclosed by Chan. The groove functions to prevent the mouse from slipping off the thumb T and middle finger M when the mouse is picked up (see column 4, lines 13-17; column 3, lines 45-49; Drawings). Additionally, groove 122 accommodates arms 210 for snapping rear extension 200 to mouse 100 (see column 6, lines 15-19; Drawings). Accordingly, touch pads on the sidewall surface of the Chan computer mouse would interfere with the ability of the user to physically manipulate the mouse or add the rear extension, as Chan teaches.

Therefore, it **would not** have been obvious to have included a touch pad in a sidewall cavity of the computer mouse of Chan because 1) neither the Chan reference nor the Gillick et al. reference teaches a touch pad or use of a touch pad; and 2) because buttons or touch pads on the sidewall surfaces of the Chan computer mouse would interfere with the ability of the user to physically manipulate the mouse or to allow for addition of the rear extension, as Chan teaches.

For these reasons, Applicant submits that the combination of Chan and Gillick et al. does not suggest or make obvious the claimed subject matter of claim 31. Accordingly, the Examiner has not shown that Applicant's claimed

product is structurally the same as that of the cited references and the Examiner is requested to withdraw this rejection.

4. Claims 13-17 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Chan U.S. Patent No. 6,359,611 in view of Zagnoev U.S. Patent No. 5,936,555.

• **Specifically regarding the rejection of claim 13:**

The limitations of claim 13 specify an auxiliary computer keyboard with a keyboard housing having at least one mechanical mouse button and at least one touch pad positioned in the keyboard housing. The Examiner has indicated that *“Chan does not teach the incorporation of the mouse into a computer keyboard.”* The Examiner cites Zagnoev as teaching a mouse embedded in an auxiliary keyboard. The Examiner further indicates that *“It would have been obvious to one skilled in the art to add a mouse into a keyboard because of its extreme conventionality and the added value of space-saving and convenience factors.”* However, it is unclear to Applicant which reference cited by the Examiner is being modified. The basis of the rejection is Chan in view of Zagnoev. However, it appears that Zagnoev is being modified. In any event, it is noted that neither Chan nor Zagnoev teach using touch pads. Accordingly, neither reference meets the limitation of “at least one touch pad positioned in said keyboard housing”, as recited in claim 13.

Therefore, it would not have been obvious to have modified Zagnoev to include a touch pad because 1) neither the Chan reference nor the Zagnoev reference teaches a touch pad, or use of a touch pad; and 2) because Chan does not teach an auxiliary computer keyboard.

For these reasons, Applicant submits that the combination of Chan and Zagnoev do not suggest or make obvious the claimed subject matter of claim 13. Accordingly, the Examiner has not shown that Applicant’s claimed product is structurally the same as that of the cited references and the Examiner is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 14:**

The rejection of claim 14 should be withdrawn because claim 14 depends from claim 13 which requires an auxiliary computer keyboard, comprising a keyboard housing with a mechanical mouse button and touch pad positioned in the keyboard housing. Neither the Chan reference nor the Zagnoev reference teaches using touch pads nor do the references teach touch pads integrated into a cavity opening formed in a keyboard housing.

Therefore, it **would not** have been obvious to have modified Zagnoev to include a touch pad because 1) neither the Chan reference nor the Zagnoev reference teaches a touch pad, or use of a touch pad; and 2) because Chan does not teach an auxiliary computer keyboard.

For these reasons, Applicant submits that the combination of Chan and Zagnoev do not suggest or make obvious the claimed subject matter of claims 13 and 14. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of the cited references and the Examiner is requested to withdraw this rejection.

- **Specifically regarding the rejection of claims 15 and 16:**

The limitation of claim 15 recites that the mechanical mouse button is a press and lock button. The limitation of claim 16 recites that the mechanical mouse button is a sliding panel button. The Examiner indicated that claims 15 and 16 are rejected with the same reasoning presented in the rejection of claims 3 and 4. However, it is noted that the Zagnoev reference was not used in the rejection of claims 3 and 4. It is unclear how Zagnoev is being used in the rejection of claims 15 and 16, because Zagnoev does not meet the claimed limitations.

It appears that the Examiner is implying that Chan teaches a press button and that Zagnoev teaches that the different button types claimed are well known in the art. However, Zagnoev does not teach the use of press and lock buttons or sliding panel buttons. Therefore, Zagnoev does not teach the equivalency of press buttons to press and lock buttons and sliding panel

buttons. Accordingly, there is no suggestion or motivation in the Zagoev reference to replace the press button of Chan with a press and lock button or a sliding panel button because neither Chan nor Zagoev suggest or teach Applicant's claimed mechanical mouse buttons of claims 15 and 16. Further, there is no suggestion or motivation in Chan to replace the buttons of Zagoev with a press and lock button or a sliding panel button because neither Chan nor Zagoev suggest or teach Applicant's claimed mechanical mouse buttons. Neither Zagoev nor Chan teach the equivalency of the claimed mechanical mouse button types. The references must provide the teaching that the Examiner is relying on. Note that Chan is specific in the type of mouse button design to be used, because the button type functions properly in the Chan invention. Therefore, the Examiner cannot rely on Zagoev for motivation to modify Chan. Further, the Zagoev reference does not overcome the deficiencies of the Chan reference with regard to claim 13. Accordingly, the rejection of claims 15 and 16 should be withdrawn.

The Examiner further indicates, "Claims 15 and 16 are rejected with the same reasoning presented in the rejection of claims 3 and 4." That rejection indicates "...there is no disclosed criticality as to why a press and lock button or a slide panel button must be used in the claimed invention." And that "Nowhere in the specification does the applicant explicitly outline the unique advantages of implementing these particular button types." In response, there is no requirement that an invention produce an advantage or provide criticality to be patentable – it need only be non-obvious.

It is noted that the Examiner has not provided an obvious statement for using Chan in view of Zagoev to reject claims 15 and 16.

Therefore, it would not have been obvious to have modified the teachings of Chan using Zagoev because neither reference teaches the equivalency of press buttons to press and lock buttons and sliding panel buttons and Chan is specific for a single type of mouse button design. Further, combining the two references does not produce Applicant's claimed invention.

For these reasons, Applicant submits that the combination of Chan and Zagoev do not suggest or make obvious the claimed subject matter of claims

15 and 16. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of the cited references and the Examiner is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 17:**

The limitation of claim 17 recites that the touch pad is integrated into a cavity opening formed in the mechanical mouse button. The Examiner indicated in the rejection that ***"Claim 17 is rejected with the same reasoning presented in the rejection of claim 10."*** However, it is noted that Zagnoev was not used in the rejection of claim 10. It is further unclear how Zagnoev is being used in the rejection of claim 17, because Zagnoev does not meet the claimed limitations. Additionally, Chan does not meet the claimed limitations. There are distinct differences between claim 10 and claim 17. Claim 10 is drawn to an auxiliary computer mouse and claim 17 is drawn to an auxiliary computer keyboard.

It appears that the Examiner is relying on Chan to teach a touch pad integrated into a cavity opening formed in the mechanical mouse button. However, Chan does not teach an auxiliary computer keyboard, nor does Chan teach a touch pad integrated into the cavity of a mechanical mouse button. Chan does not teach a touch pad or using a touch pad at all. Chan actually teaches away from using touch pads by describing what are believed by Chan to be disadvantages of touch pads. At column 2, lines 11-12, Chan teaches that ***"The touch pad also suffers from similar disadvantages when making a selection."*** And at column 2, lines 19-22, Chan teaches with respect to touch pads that ***"Because there is no distinct mechanical clicking associated with the act of selection, the user is not provided with an immediate sensory feedback to signal a successful selection."*** Accordingly, it is neither the intention nor the desire of Chan to incorporate touch pads into a computer mouse. In the rejection of claim 10 (the Examiner has indicated that the rejection of claim 10 applies for claim 17), the Examiner indicated that item 155 is a touch pad. However, Chan discloses that item 155 is a depression (see column 5, line 15). Also, at column 5, lines 24-26, Chan

discloses “...*extending index finger F against the wall of depression 155, causing mouse 100 to move in the y direction.*” And at column 5, lines 27-29, “...*movement of index finger F against the wall of depression 155, causing the mouse 100 to move in the x direction.*” Accordingly, item 155 is a depression and not a touch pad, and Chan does not teach a touch pad in the cavity of a mechanical mouse button. The depression 155 functions to aid the user of the mouse to move the mouse in a particular direction and does not and could not function as a mouse pad.

Applicant’s invention specifically teaches that the touch pad is integrated *into a cavity opening* of the mechanical mouse button. The Chan reference does not teach these limitations.

The Zagnoev reference does not overcome the deficiencies of the Chan reference with regard to claim 17. Zagnoev does not teach a touch pad in the cavity of a mechanical mouse button. In fact, Zagnoev does not at all address touch pads or their use.

It is noted that the Examiner has not provided an obvious statement for using Chan in view of Zagnoev to reject claim 17.

For these reasons, Applicant submits that the combination of Chan and Zagnoev do not suggest or make obvious the claimed subject matter of claim 17. Accordingly, the Examiner has not shown that Applicant’s claimed product is structurally the same as that of the cited references and the Examiner is requested to withdraw this rejection.

5. **Claims 18-21, 23, and 32 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Chan U.S. Patent No. 6,359,611 in view of Collas et al. U.S. Patent No. 5,473,347:**

• **Specifically regarding the rejection of claim 18:**

Initially, it is noted that the basis of the rejection is unclear. Claims 18-20 and 32 depend from claim 13. It is noted that the Examiner rejected claim 13 over Chan in view of Zagnoev. The basis of the rejection of claims 18-20 and 32 does not include Zagnoev – only Chan in view of Collas.

The Examiner also refers back to the rejection of claim 11 indicating *“Much like the reasoning offered in the rejection of claim 11, placing the mouse buttons on the sidewall of a computer keyboard is also very customary in the art.”* It is noted that claim 11 was rejected by the Examiner using Chan in view of Gillick et al. The basis of the rejection of claims 18-21, 23, and 32 does not include Gillick et al. – only Chan in view of Collas. For the record, Gillick et al. do not teach the use of touch pads in a cavity opening formed in a sidewall of a keyboard housing.

It is noted that the Examiner has not provided an obvious statement for using Chan in view of Collas to reject claim 18.

It is also noted that claim 18 is drawn to “auxiliary computer keyboard”, which is not disclosed by Collas or Chan. The Collas invention is drawn to laptop computers and does not meet the claimed limitation of an auxiliary computer keyboard. The Chan reference, likewise, does not teach an auxiliary computer keyboard. Additionally, claim 18 claims a touch pad integrated into a cavity opening formed in a sidewall of the keyboard housing. Neither the Collas reference nor the Chan reference teaches touch pads or using touch pads. Collas actually teaches using a joystick (see Abstract; column 3, lines 3-10).

For these reasons, Applicant submits that the combination of Chan and Collas do not suggest or make obvious the claimed subject matter of claim 18. Accordingly, the Examiner has not shown that Applicant’s claimed product is structurally the same as that of the cited references and the Examiner is requested to withdraw this rejection.

• **Specifically regarding the rejection of claim 19:**

It is noted that claim 19 is drawn to an auxiliary computer keyboard, which is not disclosed by either the Collas reference or the Chan reference. The Collas invention is drawn to a laptop computer and does not meet the claimed limitations of an auxiliary computer keyboard. Additionally, claim 19 depends from claim 13 which claims a touch pad positioned in the keyboard housing. Neither the Collas reference nor the Chan reference



teaches touch pads or using touch pads. Collas actually teaches using a joystick (see Abstract; column 3, lines 3-10).

It is noted that the Examiner has not provided an obvious statement for using Chan in view of Collas to reject claim 19.

For these reasons, Applicant submits that the combination of Chan and Collas do not suggest or make obvious the claimed subject matter of claim 19. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of the cited references and the Examiner is requested to withdraw this rejection.

• **Specifically regarding the rejection of claim 20:**

It is noted that claim 20 is drawn to an auxiliary computer keyboard, which is not disclosed by Collas or Chan. The Collas invention is drawn to a laptop computer and does not meet the claimed limitations of an auxiliary computer keyboard. Additionally, claim 20 depends from claim 13 which claims a touch pad positioned in the keyboard housing. Neither the Collas reference nor the Chan reference teaches using touch pads. Collas actually teaches using a joystick (see Abstract; column 3, lines 3-10). Also, claim 20 recites the limitation of a mechanical mouse button having at least one finger-pressing device formed thereon. There is no disclosure in the Collas or Chan references of providing mouse buttons having finger-pressing devices.

It is noted that the Examiner has not provided an obvious statement for using Chan in view of Collas to reject claim 20.

For these reasons, Applicant submits that the Chan and Collas references, either alone or in combination, do not suggest or make obvious the claimed subject matter of claim 20. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of the cited references and the Examiner is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 21:**

The rejection of claim 21 should be withdrawn because the references do not teach the combination of claims 1 and 21, wherein the claimed structure of a mechanical press button is not taught as having a touch pad integrated into a cavity opening formed in the mechanical mouse button. Neither the Collas reference nor the Chan reference teaches touch pads or using touch pads. Collas actually teaches using a joystick (see Abstract; column 3, lines 3-10).

It is noted that the Examiner has not provided an **obvious statement** for using Chan in view of Collas to reject claim 21.

For these reasons, Applicant submits that the combination of Chan and Collas do not suggest or make obvious the claimed subject matter of claims 1 and 21. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of the cited references and the Examiner is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 23:**

It is noted that claim 23 is drawn to an auxiliary computer keyboard, which is not disclosed by Collas or Chan. The Collas invention is drawn to a laptop computer and does not meet the claimed limitations of an auxiliary computer keyboard.

Additionally, claim 23 depends from claim 1 which requires a mouse button having a touch pad integrated into a cavity opening formed in the mechanical mouse button. Neither the Collas reference nor the Chan reference teaches touch pads or using touch pads. Further, the references do not teach using touch pads integrated into a cavity opening formed in the mechanical mouse button.

It is noted that the Examiner has not provided an **obvious statement** for using Chan in view of Collas to reject claim 23.

For these reasons, Applicant submits that the references of Chan and Collas, either alone or in combination, do not suggest or make obvious the claimed subject matter of claim 23. Accordingly, the Examiner has not shown

that Applicant's claimed product is structurally the same as that of the cited references and the Examiner is requested to withdraw this rejection.

- **Specifically regarding the rejection of claim 32:**

It is noted that claim 32 is drawn to an auxiliary computer keyboard, which is not disclosed by either the Collas reference or the Chan reference. The Collas invention is drawn to a laptop computer and does not meet the claimed limitations as recited in claim 32. Note that claim 32 recites that the keyboard housing is separate from the central processing unit housing. Neither the Chan reference nor the Collas reference addresses or meets this limitation. The Collas reference is a laptop computer wherein the keyboard housing and the central processing unit housing are the same. The Chan reference is drawn to an external mouse and does not address this limitation. Accordingly, neither the Chan reference nor the Collas reference teach a keyboard housing that is separate from the central processing unit housing.

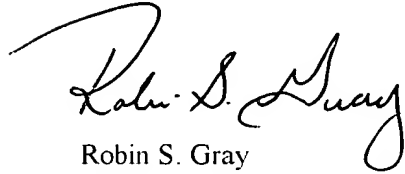
Additionally, claim 32 depends from claim 13, which is drawn to an auxiliary computer keyboard having a keyboard housing, mechanical mouse button, and a touch pad. Neither the Collas reference nor the Chan reference teaches touch pads or using touch pads. Nor do the references teach a touch pad positioned in the auxiliary computer keyboard housing.

It is noted that the Examiner has not provided an obvious statement for using Chan in view of Collas to reject claim 32.

For these reasons, Applicant submits that the references of Chan and Collas, either alone or in combination, do not suggest or make obvious the claimed subject matter of claim 32. Accordingly, the Examiner has not shown that Applicant's claimed product is structurally the same as that of the cited references and the Examiner is requested to withdraw this rejection.

Applicant respectfully submits that the above arguments place the application for patent in condition for allowance and early notification to that effect is respectfully requested.

Respectfully submitted,



Robin S. Gray

Registration No.: 48,093

I hereby certify that this correspondence is being deposited with the United States Postal Service as Post Office To Addressee with Express mail label Number: EL507535264US addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria Virginia 22313-1450, on March 15, 2004.

Robin S. Gray

Applicant

Signature

March 15, 2004

Date of Signature